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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,985	05/11/2001	Denes Marton	6006-023	6863

7590

10/16/2003

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EXAMINER
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NERBUN, PETER P

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 10/16/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/853,985

Applicant(s)

MARTON, DENES

Examiner

Peter P Nerbun

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-18 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,8,9,16-18,22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,13,19,24 and 25 is/are rejected.
- 7) ☒ Claim(s) 14,15 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 7.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1,5,6,10-13,24, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by McGuinness, newly cited. The patent to McGuinness discloses an implantable medical device comprising a self-supporting structural member fabricated of a plurality of laminated layers of at least one biocompatible material, wherein the plurality of laminated layers forms a substantially monolithic structure. Note col. 3, lines 10-20 and lines 24-25 of McGuinness which state that stent-grafts can be made from stainless steel tubular bodies that are chemically etched to form a pattern that appears as a set of cylindrical elements. The etching process forms superposed layers that integrally united. The defining characteristic of laminated layers is that they are superposed and united. The plurality of laminated layers forms a substantially monolithic structure since the layers consist a single unit (i.e. a single tubular piece of

stainless steel that has been chemically etched to define the layer structure). With regard to claim 6 note that the self-supporting structural member may comprise a planar film (see col. 6, lines 52-55 which states that the stent can be formed from a flat sheet of material that is subjected to an electronic discharge machine).

Claims 14,15, and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 3,4,8,9,16-18,22, and 23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

Applicant's election with traverse of the election requirement in Paper No. 9 is acknowledged. The traversal is on the ground(s) that "any and all claims to a species are either linked by a generic claim or are sufficiently similar so that the Patent Office would not be unduly burdened in its search". Applicant further states that "claim 1 represents a generic claim that, if allowed, links the other pending species claimed as spelled out in MPEP 809.02". This is not found persuasive because MPEP 809 states that "Where, upon examination of an application containing claims to distinct inventions, linking claims are found, restriction can nevertheless be required.". As further set forth in MPEP 809 a restriction requirement must be withdrawn only after a linking claim has been allowed. In the instant Office action generic claim 1 has been rejected. With regard to applicant's assertion that the claims are sufficiently similar so that the Patent

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Office would not be unduly burdened in its search the examiner notes that an election of species requirement is proper whenever there are multiple species claimed that are patentably distinct from each other and there is no allowable generic claim linking all the species. No exception is made in the MPEP for the level of burden that the search may present. In the instant application applicant presents claims directed to the patentably distinct species of a stent, a graft, and a stent-graft. Presently no generic claim has been allowed. Therefore the election of species requirement is proper and continues to apply.

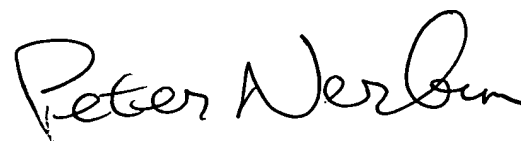
The requirement is still deemed proper and is therefore made FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter P Nerbun whose telephone number is 703-308-0955. The examiner can normally be reached on M-F (1st Week) M-Th (2d Week).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J Calvert can be reached on 703-305-1025. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

Peter Nerbun  
October 10, 2003



Peter Nerbun  
Primary Examiner